APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,751	01/19/2001	Ernest Cohen	APP 1277-US	8892

				EXAMINER
9941	7590	11/07/2003		ELISCA, PIERRE E

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ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/765,751	Ernest Cohen
	Examiner	Art Unit
	Pierre E. Elisca	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>*THREE*</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>*08/21/2003*</u> .

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>*1-27 and 29-34*</u> is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>*1-27 AND 29-34*</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some* c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

RESPONSE TO AMENDMENT

1.   This Office action is in response to Applicant's amendment, filed on 08/21/2003.

2.   Claims 1-27, and 29-34 are presented for examination.

NOTE

3.   Claim 28 is missing from this application.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

Rejection under 35 U.S.C. 102 (e),Patent Application Publication or Patent to Another with

Earlier Filing Date, in view of the American Inventors Protection Act of 1999 (AIPA) and the

Intellectual Property and High Technology Technical Amendments Act of 20902.

(e) the invention was described in (1) an application for patent, published under section 122 (b), by

another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section

351 (a) shall have the effects for purposes of this subsection of an application filed in the United

States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

5. **Claims 1-27 and 29-34 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kuroda et al. (U.S. Pat. No. 6,421,779).**

As per claims 1, 4, 6-9, 11, 13-16, 18, 21-25, 27, 30, and 31-33 Kuroda discloses an electronic data storage function identification information using a medium such as a floppy disk, etc. to, for example, a hardware vendor which generates the electronic data storage function, comprising the steps of: obtaining transaction information from <u>an on-line</u> vendor (see., col 15, lines 43-47, col 17, lines 13-20, **Kuroda further discloses an internet or on-line apparatus for performing electronic data transactions see., fig 36, col 21, lines 12-26)**;

obtaining user information, including a secret key from a user (see., col 14, lines 43-52, specifically wherein it is stated that the user can simply inputs the authentication information data to the electronic data storage, and obtain a storage certificate for each of the operations. The electronic data with authentication information can be encrypted (encrypted or secret key or private key) for output using a master key);

electronically performing a message authentication code (MAC) function on at least some of the transaction information and some of the user information (see., col 12, lines 56-67, col 13, lines 23-29); and

using a result of the MAC function as private transaction information (see., col 12, lines 56-67, specifically wherein it is stated that the electronic data storage uses as data the result of linking the electronic data with the transaction identifier, and generates an authentication information MAC using a master key). Kuroda further discloses the step of comparing or verifying a result of the received information (see., col 13, lines 6-22, and also it is inherent to know that the MAC of Kuroda can be used as a credit card).

As per claims 2, 5, 10, 12, 19, 26, and 29, Kuroda discloses the claimed method wherein the step of obtaining information comprises obtaining at least one of a name of the vendor, a URL, a transaction amount, a date of transaction, and a time of transaction (see., fig 29, col 18, lines 22-28, specifically wherein it is stated that the information and the number are stored for each vendor name).

As per claims 3, 17, 20, and 34 Kuroda discloses the claimed method wherein said adding a counter value to the transaction information (see., abstract, col 2, lines 47-54, specifically wherein it is stated the authentication information data output device externally outputs the electronic data stored in the data storage device, it adds to the electronic data).

REMARKS

6.   In response to Applicant's arguments, Applicant argues that the Kuroda reference fails to disclose " an on-line vendor provides transaction information i.e information related to the exchange

between the user and the vendor". As stated above, the Kuroda reference discloses an internet or on-line apparatus for performing electronic data transactions see., fig 36, col 21, lines 12-26.

b. Applicant also argues that the Kuroda reference fails to disclose "electronically performing a message authentication code (MAC) function on at least some of the transaction information". However, the Examiner respectfully disagrees since Kuroda discloses this limitation in col 12, lines 56-67, specifically wherein it is stated that the electronic data storage uses as data the result of linking the electronic data with the transaction identifier, and generates an authentication information MAC using a master key) .

Conclusion

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

(703) 305-7687

Pierre Eddy Elisca

Patent Examiner

October 31, 2003